



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,409	02/21/2002	Francine Baldo	219928US0	5630
22850	7590	08/06/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			YU, GINA C	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 08/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/078,409

Applicant(s)

BALDO ET AL.

Examiner

Gina C. Yu

Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 28 June 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-42.Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER

Art Unit: 1617

Continuation from No. 5:

Applicants' arguments have been considered but are not persuasive.

Applicants argue that the addition of polyols to the compositions in Breton (US 6124364) and Pillai ("6358517") is only optional. Examiner respectfully disagrees. In Breton, the specific examples comprising butylene glycol or glycerin in the weight amount of 2, 5, 7, or 10 % are taught. Whether the reference explicitly states the "concentration range" of the polyols to be used or not, using these amounts of polyols in a composition comprising the hydroxystilbene is well known in the art. While the claimed weight ratio of polyol:stilbene (150:1) is larger than that of the illustrated examples, the reference teaches to use 0.001-10 % of the hydroxystilbene. Thus, the claimed weight ratio of 150:1 is clearly within the obvious range taught by the Breton patent. As for the Pillai reference, the references also teach the amount of polyols and the stilbene to be combined, which are within the claimed range.

Applicants also argue that the references fail to teach applicants' reason to add the claimed amount of the polyols with the hydroxystilbene. Applicants assert that the claimed amount of polyols is necessary to solubilize the hydroxystilbene. However, it must be noted that claimed invention is a composition and not a method of using polyols. The combination of hydroxystilbene and polyols in the claimed weight range is well known in cosmetic art, as evidenced by Breton and Pillai.

While applicants argue that the teaching in Pillai is "too general", examiner asserts in response that the claimed weight ratio is also general because the

Art Unit: 1617

limitation claim 1 only refers to the ratio rather than any specific weight amount. A composition comprising any amounts of the two components would meet the claimed limitation so long as the claimed limitation is within the weight range of the prior art.

With respect to the argument that the term "effective amount" is a real limitation, examiner asserts that the applicants' cited authority *Abbot Laboratories v. Baxter Pharmaceutical Products, Inc.*, is not applicable in this case. The case law is directed to the significance of the term "effective amount" and "sufficient amount" in method claims. As noted above, the present invention is a composition. Examiner is of the position that term "effective amount" does not carry the same significance as in the method claims because, as noted above, the claimed invention is a composition of matter and not method of using the compounds. The method of using polyols to solubilize the hydroxystilbene is clearly out of the scope of this invention.

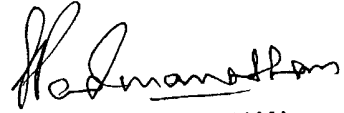
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER